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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/189,574 11/11/98 DUBRUL

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QM32/0606

EXAMINER

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GOLDBERG, J

ART UNIT

PAPER NUMBER

3731

DATE MAILED:

06/06/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/189,574

Applicant(s)
Dubrul et al.

Examiner
Jonathan Goldberg

Group Art Unit
3731



☒ Responsive to communication(s) filed on Mar 13, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-34 is/are pending in the applicat

Of the above, claim(s) 1-25 is/are withdrawn from consideration

☒ Claim(s) 26-29 is/are allowed.

☒ Claim(s) 30-34 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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DETAILED ACTION

1. Note: Although the Examiner was initially leaning towards allowing the amended claims, the Examiner states that, upon further review of the claimed subject matter, the following observations were made:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 26 recites the limitation "said blocking element" in lines 9 and 10, for example. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests "said multi-wing malecot style blocking element".

Also, Claim 26 recites the limitation "said engaging element" in lines 16, 21, and 23, for example. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests "said multi-wing malecot style blocking element".

4. Applicant is requested to review and correct all claims for similar problems.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel et al. (5,814,064). With respect to the claims, Figures 13a-13b of Daniel et al. discloses by illustration all the limitations of the claims including: multi-wing blocking element [plurality of slots (128)], annular membrane (130) (i.e.: microporous membrane), and actuator [mandrel (132) in conjunction with tube (124)]. Daniel et al. discloses that the slots may be made of nitinol and/or the membrane may be of shape memory material (i.e.: elastomeric). Refer to Col. 7, lines 47- bottom and Col. 8, lines 1-26 with an alternate embodiment disclosed in Col 8, lines 27-65.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. Daniel et al. discloses a device for placement into a body passageway with such features which are capable of carrying out the steps substantially as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the device of Daniel et al. as a manner by which to filter and remove particulate from the blood stream.

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9. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (5,549,626). Miller et al. discloses a filtering device for placement into a body passageway with such features which are capable of carrying out the steps substantially as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the device of Miller et al. as a manner by which to entrap blockages in the vascular system.

Allowable Subject Matter

10. Claims 26-29 are allowed. The prior art fails to suggest a filtering or capturing device with blocking element and occluding element as claimed. Daniel et al. (5,814,064) discloses a filter with blocking element lacking the occluding element. Gunther et al. (5,329,942) discloses a catheter with filtering trap, but there is no suggestion or teaching to combine with other elements as claimed in the instant invention. Finally, Lindenberg et al. (5,518,498) discloses of a drainage device with structure including malecot-type blocking element; however, there is no disclosure of an occlusion engaging element. Furthermore, it would be improper to combine the drainage device of Lindenberg et al. with an occlusion device which is designed to block or obstruct. Hence, such a combination would thereby prevent said drainage device from draining a bladder, for example, as disclosed in the specification.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan (Jon) Goldberg whose telephone number is (703) 308-0161. The examiner can normally be reached Monday through Friday from 8:00 AM to 3:00 PM (ET).

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 308-2708

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.



Jonathan D. Goldberg

05/31/00



MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300

5/31/00